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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,840	09/01/2000	James K. Beriker	254/180	5735
7590 02/08/2006 NIRO SCAVONE HALLER & NIRO ROBERT P GREENSPOON 181 W MADISON SUITE 4600 CHICAGO, IL 60602			EXAMINER LUDWIG, MATTHEW J	
			ART UNIT 2178	PAPER NUMBER

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/653,840

Applicant(s)

BERIKER ET AL.

Examiner

Matthew J. Ludwig

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is in response to the amendment filed 11/17/05.
2. Claims 1-5 remain pending in the application. Claim 1 is an independent claim.
3. Claims 1-5 ***remain rejected*** under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Harvey.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight et al., USPN 6,804,675 filed (3/17/03) in view of Harvey et al., USPN 6,519,629 filed (10/2/01).**

**In reference to independent claim 1, Knight teaches:**

In response to the user specified search parameters, a request is sent to community search robot (or customized search robot at server, which in turn queries database management routine to retrieve entries meeting the user's search/filter criteria (compare to "***receiving a search criterion from a customer for producing search results***"). See column 11, lines 30-35.

Groups of the same matching the user's query criteria are easily and rapidly located. These entries are then transmitted to the user's computer system (compare to "***obtaining and transmitting the search results to the customer***"). See column 11, lines 35-40.

The system provides an optional linking feature, which can also be implemented so that, upon viewing such rankings in window, the user can then automatically click and see the set of postings for such author/company, etc. in message listing area and peruse them in the normal fashion. The reference discloses a clickable link, however, Knight fails to explicitly teach an invitation to be included in the target list. Harvey provides a method for creating communities in a web environment. More specifically, the reference teaches search tags/metatags to locate these communities and a presentation method to invite users to join a specific community. The invitations taught by Harvey prompt an invited user to accept an invitation and provide further information. A user may launch an executable component according to know launching methods (double clicking on an executable icon). It would have been obvious to one of ordinary skill in the art, having the teachings of Knight and Harvey before him at the time the invention was made, to modify the optional linking feature method taught by Knight to include the invitation techniques of Harvey, because the invitation would decrease the amount of links presented to the user at one time and would avoid confusion with an invited user.

**In reference to dependent claim 2, Knight teaches:**

The system provides an optional linking feature which can also be implemented so that, upon viewing such rankings in window, the user can then automatically click and see the set of postings for such author/company, etc. in message listing area and peruse them in the normal fashion. The reference discloses a clickable link, however, Knight fails to explicitly teach an invitation to be included in the target list. Harvey provides a method for creating communities in a web environment. More specifically, the reference teaches search tags/metatags to locate these communities and a presentation method to invite users to join a specific community. The

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invitations taught by Harvey prompt an invited user to accept an invitation and provide further information. By way of example only, an acceptance component may prompt a user to accept an invitation, provide user identification for the community and provide a password for the community. Other manners of providing acceptance components may also be used. See column 15, lines 20-35. It would have been obvious to one of ordinary skill in the art, having the teachings of Knight and Harvey before him at the time the invention was made, to modify the optional linking feature method taught by Knight to include the invitation techniques of Harvey, because the invitation would decrease the amount of links presented to the user at one time and would avoid confusion with an invited user.

**In reference to dependent claim 3-5, Knight teaches:**

The system provides an optional linking feature which can also be implemented so that, upon viewing such rankings in window, the user can then automatically click and see the set of postings for such author/company, etc. in message listing area and peruse them in the normal fashion. The reference discloses a clickable link, however, Knight fails to explicitly teach the step of transmitting a confirmation request using the contact information. Harvey provides a method for creating communities in a web environment. More specifically, invitations to groups require the user to accept the invitation. A user may be prompted to provide other user information, as well as enter a password and confirm it. See column 15, lines 57-61. It would have been obvious to one of ordinary skill in the art, having the teachings of Knight and Harvey before him at the time the invention was made, to modify the optional linking feature method taught by Knight to include the invitation techniques of Harvey, because the invitation would provide security to overall web community and selectivity by an author.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-5 have been considered but are not persuasive.

As presently claimed, the limitations within the independent claim fail to distinguish over the prior art of record. More specifically, applicant argues Knight and Harley do not teach or suggest 'transmitting to a user an invitation to join a target list of customers related to a search criterion submitted by the user'. However, Knight teaches an optional add-on feature, which is a tabulation window. This feature is provided as additional general interest statistical information for the members of the electronic community sharing the message board system. An entry corresponding to the top most followed companies, the most read (popular) authors, etc., can be selected instead. Finally, an additional "take me to the author's chat room" option can be implemented at this level, so further interaction can be immediately provided with popular authors on the system. See column 18, lines 1-30. The reference suggests a means of providing a user with a result set based upon a search criterion. If members of the message board continually used criteria leading to a specific author, that author would appear in the add-on feature window. This suggests search results provided to the user based on search criteria. Furthermore, the applicant believes the references fail to suggest 'the invitation which is included in the target list related to the search criterion'. The Knight reference provides the option, "take me to the author's chat room". This option suggests an invitation that is based upon most frequently found authors. It suggests a relationship between the search criteria for a specific author performed by members of the board. As presently claimed, the phrase 'invitation' fails to preclude the examiner from utilizing the message to join a chat as an invitation. The reference fails to

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explicitly state the attempt to entice members into joining a chat is an invitation; however, Harvey discloses a method for creating communities in a web environment. More specifically, the reference teaches search tags/metatags to locate these communities and a presentation method to invite users to join a specific community. The invitations taught by Harvey prompt an invited user to accept an invitation and provide further information to the system. A user may launch an executable component according to known launching methods (double clicking on an executable icon). It would have been obvious to one of ordinary skill in the art, having the teachings of Knight and Harvey before him at the time the invention was made, to modify the optional linking feature method taught by Knight to include the invitation techniques of Harvey, because the invitation would decrease the amount of links presented to the user at one time and would avoid confusion with an invited user. Finally, applicant suggests the Knight reference has nothing to do with seeding names of potential "customers". The applicant is reminded that the claims limitations are to be given their broadest reasonable interpretation within the scope of the art. Nowhere in the independent claim does it state 'seeking names of potential customers'. The broad nature of the independent claim, as presently claimed, fails to distinguish itself from the prior art of record.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

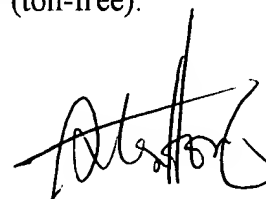
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML  
January 30, 2006



**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**